

ESTTA Tracking number: **ESTTA685141**

Filing date: **07/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218431
Party	Defendant IGT
Correspondence Address	HOPE HAMILTON HOLLAND & HART LLP PO BOX 8749 DENVER, CO 80201-8749 UNITED STATES docket@hollandhart.com, hihamilton@hollandhart.com, lm- root@hollandhart.com, trademarks@igt.com, HlHamilton@hollandhart.com, EJ- Cooper@hollandhart.com, R
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Hope I. Hamilton
Filer's e-mail	docket@hollandhart.com, hihamilton@hollandhart.com, lm- root@hollandhart.com, ejcooper@hollandhart.com, baadams@hollandhart.com
Signature	/Hope I. Hamilton/
Date	07/22/2015
Attachments	IGT's Consented Mtn w_attachments.pdf(34080 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DOUBLE DOWN, INC.,  Opposer, v. IGT,  Applicant.	<b>Opposition No.:</b> 91218431 ( <b>Parent</b> )  <b>Mark:</b> DOUBLE DOWN STUD  <b>Serial. No.:</b> 86/244,094
DOUBLE DOWN, INC.,  Petitioner, v. IGT,  Registrant.	<b>Cancellation No.:</b> 92059996  <b>Mark:</b> DOUBLEDOWN CASINO  <b>Reg. No.:</b> 3,885,409
IGT,  Petitioner, v. DOUBLE DOWN, INC.,  Registrant.	<b>Cancellation No.:</b> 92060105  <b>Mark:</b> DOUBLE DOWN SALOON  <b>Reg. No.:</b> 3,754,434

**IGT’S CONSENTED MOTION FOR LEAVE TO AMEND ITS ANSWERS**

IGT hereby moves for leave to amend its Answers to Double Down Inc.’s (i) Opposition to IGT’s Application for DOUBLEDOWN STUD (Opposition No. 91218431), and (ii) Petition for Cancellation of IGT’s Registration for DOUBLEDOWN CASINO (Cancellation No. 92059996), to plead sufficient factual allegations supporting IGT’s affirmative defenses, as contemplated by the Board’s July 15, 2015 order in these consolidated proceedings. Double Down, Inc. consents

only to the filing of amended answers with respect to IGT's affirmative defenses, and reserves its rights to challenge the sufficiency of the pleadings and the merits of IGT's defenses, as amended.

Contingent on the Board granting this motion, Registrant requests that IGT's FIRST AMENDED ANSWER TO PETITION FOR CANCELLATION (attached as Exhibit A hereto) and IGT's FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION (attached as Exhibit B hereto) be received by the Board and accepted as IGT's operative Answers in this consolidated proceeding.

July 22, 2015

Respectfully submitted,

/Hope Hamilton/  
Donald A. Degnan  
Hope Hamilton  
HOLLAND & HART LLP  
P.O. Box 8749  
Denver, Colorado 80201-8749  
Phone: (303) 473-4822  
Facsimile: (303) 416-8842

**Attorneys for Registrant, IGT**

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Consented Motion for Leave to Amend It's Answers has been served on July 22, 2015, to the following by e-mail and U.S. First Class Mail, postage prepaid:

Laura E. Bielinski (lbielinski@bhfs.com)  
Nikki L. Baker (nbaker@bhfs.com)  
Erin E. Lewis (elewis@bhfs.com)  
Brownstein Hyatt Farber Schreck LLP  
100 North City Parkway, Suite 1600  
Las Vegas, Nevada 89106-4614

/Barbara A. Adams/  
Barbara A. Adams

7929102\_2

# **EXHIBIT A**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>DOUBLE DOWN, INC.,</p> <p style="text-align:right">Petitioner,</p> <p style="text-align:center">v.</p> <p>IGT,</p> <p style="text-align:right">Registrant.</p>	<p><b>Cancellation No.:</b> 92059996<sup>1</sup></p> <p><b>Mark:</b> DOUBLEDOWN CASINO</p> <p><b>Reg. No.:</b> 3,885,409</p>
---	--

**IGT’S FIRST AMENDED ANSWER TO PETITION FOR CANCELLATION**

IGT (“Registrant”), by and through its attorneys, answers Petitioner Double Down, Inc.’s Petition for Cancellation as follows:

[Unnumbered Paragraph]. Applicant denies that Petitioner will be damaged by Registrant’s Mark DOUBLEDOWN CASINO (U.S. Registration No. 3885409). Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of the unnumbered paragraph and therefore denies them.

1. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 1 and therefore denies them.

2. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies them.

3. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 3 and therefore denies them.

4. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies them.

---

<sup>1</sup> This proceeding has been consolidated with Opposition No. 91218431 (Parent) and Cancellation No. 92060105; however, for clarity, IGT has retained the original caption for this answer.

5. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 5 and therefore denies them.

6. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 6 and therefore denies them.

7. Registrant admits that Petitioner is listed as the owner of U.S. Registration Nos. 3085525 and 3754434, the contents of which speak for themselves (hereinafter, the “Class 43 Registration” and the “Class 41 Registration,” respectively). Registrant also admits that both registration certificates include a disclaimer of the word SALOON. Registrant denies that Petitioner owns or has any rights in the mark DOUBLE DOWN SALOON or DOUBLE DOWN for casino services and further states that Petitioner’s Class 41 Registration is the subject of a separate cancellation proceeding (No. 92060105). Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 7 and therefore denies them.

8. Registrant admits that Petitioner is listed as the owner of U.S. Application Serial Nos. 86/205,284 (“Petitioner’s Class 43 Application”) and 86/205,273 (“Petitioner’s Class 41 Application”), the contents of which speak for themselves. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8 and therefore denies them.

9. Registrant admits Petitioner’s Class 43 Application was published for opposition on or around July 15, 2014. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 9 and therefore denies them.

10. Registrant admits that the USPTO issued an Office Action on or about June 4, 2014, refusing registration of Petitioner’s Class 41 Application “because of a likelihood of

confusion with the mark in U.S. Registration No. 3885409.” Registrant denies the remaining allegations of Paragraph 10.

11. Registrant admits that it owns U.S. Registration No. 3885409 for the mark DOUBLEDOWN CASINO for “entertainment services, namely, providing an on-line computer game” in International Class 41. Registrant further admits that it is a Nevada corporation. Registrant denies the remaining allegations of Paragraph 11.

12. Registrant admits that Pickjam LLC filed a use-based application bearing Serial No. 77/967,593, the contents of which speak for itself. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 12 and therefore denies them.

13. Registrant states that the content of Pickjam LLC’s application bearing Serial No. 77/967,593 speaks for itself. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 13 and therefore denies them.

14. Registrant admits that U.S. Registration No. 3885409 was issued on December 7, 2010. Registrant also admits that U.S. Registration No. 3885409 is the subject of this Petition for Cancellation. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 14 and therefore denies them.

15. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 15 and therefore denies them. Registrant further states that the USPTO records speak for themselves.

16. Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 16 and therefore denies them. Registrant further states that the USPTO records speak for themselves.



17. Registrant admits that it acquired U.S. Registration No. 3885409 by assignment from Double Down Interactive LLC and that the assignment was recorded with USPTO on or around August 19, 2014. Registrant further states that the USPTO records speak for themselves and denies the remaining allegations in Paragraph 17.

18. Registrant denies the allegations of Paragraph 18.

19. Registrant admits that the USPTO has refused registration of Petitioner's Class 41 Application "because of a likelihood of confusion with the mark in U.S. Registration No. 3885409." Registrant denies the remaining allegations of Paragraph 19.

20. Registrant denies the allegations of Paragraph 20.

21. Registrant admits that Petitioner's Class 41 Registration and Class 41 Application list casino services, which are the same or highly related to the services rendered under Registrant's famous, prior used, and prior registered DOUBLEDOWN CASINO mark, U.S. Registration No. 3885409. Registrant denies the remaining allegations of Paragraph 21.

22. Registrant denies the allegations of Paragraph 22.

23. Registrant denies the allegations of Paragraph 23.

24. Registrant denies the allegations of Paragraph 24.

### **AFFIRMATIVE DEFENSES**

#### **FIRST DEFENSE (Failure to State a Claim)**

The Petition for Cancellation fails to state claims upon which relief can be granted. Even if Petitioner has stated a valid claim for likelihood of confusion, no relief may be granted on that claim because Petitioner waited nearly four years after Registrant's registration issued on December 7, 2010 to file the instant Petition.

**SECOND DEFENSE**  
**(Registrant Has Priority; Petitioner's Class 41 Registration is Invalid)**

The Petition is barred because Registrant has priority in DOUBLE DOWN due to its rights in the incontestable mark DOUBLE DOWN STUD for “money-operated game machines”—goods substantially related to casinos services—dating back to at least November, 1992. Petitioner's Class 41 Registration for casino services is therefore invalid and subject to cancellation, which is also the subject of a separate Petition for Cancellation (No. 92060105).

**THIRD DEFENSE**  
**(Laches, Estoppel, Acquiescence)**

The Petition is barred in whole or in part by the doctrines of laches, estoppel, and/or acquiescence, because Registrant's Registration for DOUBLEDOWN CASINO issued on December 7, 2010. Petitioner waited nearly four years before seeking cancellation, and Petitioner had constructive and actual knowledge of Registrant's and its predecessors' use of the DOUBLEDOWN CASINO mark during this time. Moreover, Petitioner also had knowledge of Registrant's investments in and expansion of the DOUBLEDOWN CASINO brand. Since registering the DOUBLEDOWN CASINO Mark, Registrant and its predecessors have grown the DOUBLEDOWN CASINO brand into the top-grossing online social casino game, generating more than \$293 million in revenue in 2014 alone. Registrant would therefore be extremely prejudiced if its DOUBLEDOWN CASINO registration were now cancelled.

At the time this Amended Answer to the Notice of Opposition is filed, all possible facts supporting all possible affirmative defenses may not yet have been discovered. Applicant therefore reserves its rights to amend this Answer to allege additional affirmative defenses if subsequent investigation so warrants

WHEREFORE, Registrant prays for judgment in its favor, dismissing the Petition for Cancellation with prejudice.

July 22, 2015

Respectfully submitted,

/Hope Hamilton/

Donald A. Degnan

Hope Hamilton

HOLLAND & HART LLP

P.O. Box 8749

Denver, Colorado 80201-8749

Phone: (303) 473-4822

Facsimile: (303) 416-8842

**Attorneys for Registrant, IGT**

## **EXHIBIT B**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>DOUBLE DOWN, INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>IGT,</p> <p style="text-align:center">Applicant.</p>	<p><b>Opposition No.:</b> 91218431<sup>1</sup></p> <p><b>Mark:</b> DOUBLE DOWN STUD</p> <p><b>Serial No.:</b> 86/244,094</p>
---	--

**IGT’S FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION**

IGT (“Applicant”), by and through its attorneys, answers Opposer Double Down, Inc.’s Notice of Opposition as follows:

[Unnumbered Paragraph]. Applicant denies that Opposer will be damaged by registration of Applicant’s DOUBLE DOWN STUD Mark (Ser. No. 86/244094) (“Applicant’s Mark”). Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of the unnumbered paragraph and therefore denies them.

1. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 1 and therefore denies them.

2. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies them.

3. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 3 and therefore denies them.

4. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies them.

---

<sup>1</sup> This proceeding has been consolidated with Cancellation No. 92059996 and Cancellation No. 92060105; however, for clarity, IGT has retained the original caption for this answer.

5. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 5 and therefore denies them.

6. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 6 and therefore denies them.

7. Applicant admits that Opposer is listed as the owner of U.S. Registration Nos. 3085525 and 3754434, the contents of which speak for themselves (hereinafter, the “Class 43 Registration” and the “Class 41 Registration,” respectively). Applicant also admits that both registration certificates include a disclaimer of the word SALOON. Applicant denies that Opposer owns or has any rights in the mark DOUBLE DOWN SALOON or DOUBLE DOWN for casino services and further states that Opposer’s Class 41 Registration is the subject of a separate cancellation proceeding (No. 92060105). Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 7 and therefore denies them.

8. Applicant admits that Petitioner is listed as the owner of U.S. Application Serial Nos. 86/205,284 (“Petitioner’s Class 43 Application”) and 86/205,273 (“Petitioner’s Class 41 Application”), the contents of which speak for themselves. Applicant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8 and therefore denies them.

9. Applicant admits that it is a Nevada corporation. Applicant denies the remaining allegations of Paragraph 9.

10. Applicant admits that, on April 7, 2014, Applicant filed an intent-to-use application to register Applicant’s Mark that was assigned Serial No. 86/244,094. Applicant further admits

that Applicant's Mark is the subject of this Notice of Opposition. Applicant denies the remaining allegations of Paragraph 10.

11. Applicant admits the allegations of Paragraph 11.
12. Applicant admits the allegations of Paragraph 12.
13. Applicant admits the allegations of Paragraph 13.
14. Applicant denies the allegations of Paragraph 14.
15. Applicant denies the allegations of Paragraph 15.
16. Applicant denies the allegations of Paragraph 16.
17. Applicant denies the allegations of Paragraph 17.
18. Applicant denies the allegations of Paragraph 18.
19. Applicant denies the allegations of Paragraph 19.

### **AFFIRMATIVE DEFENSES**

#### **FIRST DEFENSE (Failure to State a Claim)**

The Notice of Opposition fails to state claims upon which relief can be granted. Even if Opposer has stated a valid claim for likelihood of confusion, no relief may be granted on that claim because Applicant has owned the identical mark, DOUBLE DOWN STUD, for the substantially same goods ("money operated game machines") for more than twenty years—since November 19, 1992.

#### **SECOND DEFENSE (Registrant Has Priority; Opposer's Class 41 Registration is Invalid)**

The Notice of Opposition is barred because Applicant has priority in the marks DOUBLEDOWN and DOUBLE DOWN, due to its prior common law rights in those marks, in addition to its ownership of the incontestable mark DOUBLE DOWN STUD (Reg. No. 1,853,518) for "money-operated game machines" dating back to at least November 1992. Opposer's Class 41

Registration for casino services is therefore invalid and subject to cancellation, which is also the subject of a separate Petition for Cancellation (No. 92060105).

**THIRD DEFENSE**  
**(Laches, Estoppel, Acquiescence)**

The Notice of Opposition is barred in whole or in part by the doctrines of laches, estoppel, and/or acquiescence because Applicant has used and owns common law rights in the marks DOUBLE DOWN STUD, and owns an incontestable registration for the mark DOUBLE DOWN STUD (Reg. No. 1,853,518) for substantially similar goods (namely, “money operated game machines”). Applicant has used its DOUBLE DOWN STUD mark for game machines for more than twenty years. Petitioner had actual and constructive knowledge of Applicant’s use, and at no point has Petitioner conveyed any concern regarding Applicant’s use or ownership of this mark. Applicant has invested heavily in, and increased the brand awareness of the DOUBLE DOWN STUD brand, and it would be severely prejudiced if it were now denied registration of DOUBLE DOWN STUD for online games, which are a logical expansion of Applicant’s use of the DOUBLE DOWN STUD for physical gaming machines.

At the time this Amended Answer to the Notice of Opposition is filed, all possible facts supporting all possible affirmative defenses may not yet have been discovered. Applicant therefore reserves its rights to amend this Answer to allege additional affirmative defenses if subsequent investigation so warrants.

WHEREFORE, Applicant prays for judgment in its favor, dismissing the Notice of Opposition with prejudice, and finding that Applicant’s DOUBLE DOWN STUD mark be permitted to mature to registration on the Principal Register of the United States Patent and Trademark Office.



July 22, 2015

Respectfully submitted,

/Hope Hamilton/

Donald A. Degnan

Hope Hamilton

HOLLAND & HART LLP

P.O. Box 8749

Denver, Colorado 80201-8749

Phone: (303) 473-4822

Facsimile: (303) 416-8842

**Attorneys for Applicant, IGT**

7274558\_3